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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty Legal Office

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#3

Ladas & Parry
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New York, NY 10023

In re Application of
LAZAREV et al
U.S. Application No.: 09/485,168
PCT Application No.: PCT/RU98/00250
Int. Filing Date: 03 August 1998
Priority Date: 04 August 1997
Attorney Docket No.: U 012593-1
For: LIQUID CRYSTAL DISPLAY

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DECISION ON PETITION

UNDER 37 C.F.R. §1.47(a)

This is in response to applicants' "Petition Under 37 CFR 1.47," filed 19 May 2000, requesting that the present application be accepted for national stage processing without the signature of joint inventor Sergei Vasilievich Belyaev.

BACKGROUND

On 03 August 1998, applicant filed international application PCT/RU98/00250, which claimed priority of an earlier Russian application filed 04 August 1997. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 11 February 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 February 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 04 February 2000.

On 03 February 2000, applicants filed a transmittal letter for entry into the national stage in the United States. The transmittal letter was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 20 April 2000, the United States Designated/Elected Office mailed a "Notification of Missing Requirements Under 35 U.S.C. 371" (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge

under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date. The Notification of Missing Requirements set a one-month response period.

On 19 May 2000, applicants filed the present petition accompanied by, inter alia, an original declaration signed by two of the three joint inventors, the \$65.00 small entity fee for furnishing a declaration later than thirty (30) months from the priority date, and the \$130.00 petition fee required by 37 CFR 1.17(i).

On 26 June 2000, applicants filed the declaration of applicants' attorney Vladimir Biriulin in support of the present petition.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventor, (2) factual proof that the missing joint inventor refuses to join in the application or cannot be reached after diligent effort, (3) the fee set forth in 37 CFR §1.17(i), and (4) the last known address of the nonsigning joint inventor. See 37 CFR 1.47(a).

With regard to item (1), the present petition is accompanied by a declaration by joint inventors Pavel Ivanovich Lazarev and Jury Alexandrovich Bobrov on their own behalf and on behalf of the nonsigning joint inventor Belyaev.

With regard to item (2), MPEP 409.03(d) states,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. . . .

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

In the present case, applicants have submitted a letter dated 06 March 2000 sent from Carl Cobb, President of assignee Optiva, Inc., to the nonsigning inventor Belyaev. Receipt of the letter on 30 March 2000 is acknowledged by Belyaev's signature which appears to match that found on the Patent Right Assignment Contract ("Exhibit 3"). Belyaev's non-response during the period from his 30 March 2000 acknowledgment to the 19 May 2000 filing of the present petition is sufficiently long for applicants to conclude that Belyaev did not intend to respond to

the letter. However, applicants have not provided an affidavit or declaration by a party having firsthand knowledge of Belyaev's non-response. Applicants should provide an affidavit or declaration by Cobb, the author of the 06 March 2000 letter, stating that no response to the letter has been received. Furthermore, while the letter suggests that a copy of the application papers was included with the letter, applicants have not provided an affidavit or declaration by a party with firsthand knowledge of the letter's contents. Applicants should provide an affidavit or declaration by Cobb indicating that a complete copy of the application papers (including specification, claims, drawings, and oath or declaration) was sent to Belyaev at his last known address.

With regard to item (3), applicants have submitted the fee required by 37 CFR 1.17(i).

With regard to item (4), applicants have not provided the last known address of the nonsigning joint inventor. Although the original declaration lists an address for Belyaev, there is nothing in the petition, the declaration of applicants' attorney Biriulin, or any of the other supporting documentation, which indicates that the listed address is the last known address of Belyaev.


CONCLUSION

Because applicants have failed to satisfy items (2) and (4) above, the petition under 37 C.F.R. §1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.

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